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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,674	10/11/2005	Valerie De La Poterie	08048.0068	3166
22852	7590	03/22/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1619	
			MAIL DATE	DELIVERY MODE
			03/22/2010 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,674

Applicant(s)

DE LA POTERIE ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1619

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-120 is/are pending in the application.
- 4a) Of the above claim(s) 60-65 and 86-120 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-59 and 66-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/11/2006;11/08/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of election filed on 11/23/09 and IDS filed on 5/11/06 and 11/8/06. Claims 42-120 are pending in the application.

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 11/23/09 is acknowledged. The traversal is on the ground(s) that the instant application is a national stage filing under 35 U.S.C. § 371 and thus unity of invention practice applies to the application and applicants respectfully disagree with the Office's analysis of U.S. Patent Nos. 6,716,420 and 6,534,047 and the conclusion that the patents render obvious the claimed invention. Applicants reserve any further response until the issuance of an official action directed towards the elected subject matter. This is not found persuasive because as stated in the restriction requirement, the instant composition claim 42 is obvious over the combination of U.S. Patent Nos. 6,716,420 and 6,534,047 and instant composition claim 42 does not share a special technical feature with the instant process of preparing the composition or process for making up keratin fibers and, as such, unity between the above Groups I-IV is broken.

The requirement is still deemed proper and is therefore made FINAL.

Claims 86-120 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a **nonelected invention**, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/23/09.

Applicant's election with traverse of "*carnauba wax*" as species drawn to wax in the reply filed on 11/23/09 is acknowledged. The traversal is on the ground(s) that the Examiner has not shown that a serious burden exists to examine all of the alleged species. This is not found

persuasive because unity is broken and the wax can be any wax claimed in claim 60 or claim 61 or claim 62 or claim 65 or claim 68. It is serious search burden to examine all these waxes.

Claims 60-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a **nonelected species**, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 11/23/09.

Claims 42-59 and 66-85 are examined in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42-53, 55-59 and 66-85 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 7,211,244 ('244).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Specification defines solid content as "content of non-volatile matter. Fillers, non-volatile oil, waxes, film forming formers, dye stuff all are "non-volatile oil" and the addition of

the percentages of all these components meets the weight percent or the total weight percent of all these components is within the weight percent claimed in claims 43-45.

See col.12, ll 8-54 for volatile oil and the amount of volatile oil (claims 47-52); See paragraph bridging cols. 12-13 for non-volatile oil (claim 53); see col.11, l 55 through col12, line 2 for water soluble solvent (claims 55-57). see col.13, ll 58-65 for wax and melting point of wax (claims 58-59 and 66-67); see col.14, line 12 for elected species carnauba wax (claim 68); see col.14, ll 45-50 for weight percent of wax (claims 69-70) ; see col.9, line 20 through col.10, ll 50-52 for polymer (claims 71 and 76) see col10, ll 50-52 for vinyl acetate/ vinyl stearate and vinyl acetate/allyl stearate (claim 77) therefore claims 72-75 are inherent; see col6, ll 61-65 for weight percent of adherent polymer (claims 78-79); see col.10, ll 27-30 for claim 80. See col.11, ll 19-31 for dyes (claim 81); see col.15, ll 46-55 (claims 82- 83);. Patent teaches mascara compositions using the same ingredients claimed therefore claims 45-46 and 84-85 are inherent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 42-59 and 66-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 7,211,244 ('244) and 5,519, 063 ('063).

Patent '244 does not teach compositions for coating keratin fibers, wherein the composition does not have water or water soluble solvent of claim 54.

However, patent '063 teaches mascara compositions using wax and absence of water or water soluble solvent. See example F8.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to modify compositions for coating keratin fibers of patent '244 and prepare the compositions without water or water soluble solvent taught by patent '063 so that the compositions are water resistant and it is beneficial to the consumer having mascara compositions that are water resistant. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619